

## REMARKS

Claims 1-48, 53-66 and 69-73 are pending in the application, and claims 1-4, 9-11, 16-22, 24, 26-28, 32-34, 38-48, 54 and 63-66, and 69 are rejected. Claims 5-8, 12-15, 23, 25, 29-31, 35-37, 53, 55-57, 60, 62 and 70-73 are withdrawn from consideration. Claims 58, 59 and 61 are objected to. Claims 49-52, 67 and 68 were canceled previously. Claims 53 and 55-57 are amended.

Claims 1-4, 9-11, 16-22, 24, 26-28, 32-34, 38-48, 54, 63-66 and 69 are rejected under 35 USC 103(a) as obvious over Sauerberg et al. (WO 01/79150) in view of Pershadsingh et al. (US 6,028,088) and De la Brouse-Elwood et al. (US 6,200,995).

### Claim Amendments

Withdrawn claims 53 and 55-57 are amended to correct dependencies therein, as the claim from which these claims originally depended was canceled previously. No new matter is added.

### Claim Rejections – 35 USC 103

The Examiner takes the position that Sauerberg teaches the claimed invention, citing that the Y substituent of Sauerberg corresponds to -T-Z-U- in the instant compound of formula (I) (Office Action, page 4, second paragraph). Applicants respectfully disagree.

The Examiner relies on the phrase "and the like" in the definition of aryl of Sauerberg to permit expansion of the definition beyond that which one skilled in the art would consider an aryl group. The Examiner relies on two secondary references for definitions of aryl that might include divalent polycyclic ring systems (rings attached by single bonds) as instantly claimed. Applicants respectfully submit that this use of secondary references is improper in this case. A patent applicant may be their own lexicographer and may define terms (within limits) as they may see fit. To that end, Applicants searched the USPTO patent database for patents having the phrase "the term aryl" therein. The search returned over 14,000 patents. In scanning the 12 most recent patents (number 7,528,161 – 7,528,448 which contained the searched term), Applicants found that 7 out of the 12 defined aryl as **not containing** polycyclic ring systems as defined in the instant invention. In the 5 that the "aryl" definition did include rings covalently bonded together, this term was specifically recited. This evidence points toward the conclusion that, if Sauerberg wanted to include the polycyclic ring systems as instantly claimed in his own invention, such groups would be specifically called out and not left in the phrase "and the like". More to the point, one of ordinary skill in the art, based on the above, would not conclude that the Y group of Sauerberg taught or fairly suggested the use of polycyclic ring systems as instantly claimed.

Applicants respectfully submit that the Examiner picked and choose references that gave the desired result as to what one skilled in the art might recognize as the definition of aryl. However, even from the two secondary references chosen by the Examiner, one clearly **teaches away** from the proposition that aryl means polycyclic ring systems as instantly claimed. In Pershadsingh, it would appear to one skilled in the art that aryl would **not teach** groups like biphenyl, because Pershadsingh specifically recites aryl as a possible

substituent on the previously defined aryl. If aryl were defined to include biphenyl, there would appear to be no need to have an aryl attached to an aryl. Therefore, Pershadsingh teaches away from aryl meaning two rings joined together by a single bond.

In the paragraph bridging pages 4 and 5 of the Office Action, the Examiner states that "One having ordinary skill in the art ... would have reasonably believed that the phrase 'and the like' as disclosed by Sauerberg et al. would include biphenyl ... since these were common aryl substituents for compounds which are PPAR modulators or agonists. Applicants respectfully disagree. Applicants submit that "and the like" of Sauerberg is meant to capture like compounds, such as three or four aromatic rings fused together. In reviewing the art, one skilled in the art would see, as discussed above, that a patent applicant typically specifically recites rings covalently bonded together when these ring systems are meant to be included in the definition of aryl.

For the above reasons, Applicants respectfully submit that Sauerberg, alone or taken with Pershadsingh and De la Brouse-Elwood, does not teach or fairly suggest the compounds of the present invention, wherein Z is a divalent polycyclic ring system. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-4, 9-11, 16-22, 24, 26-28, 32-34, 38-48, 54, 63-66 and 69 as being rejected under 35 USC 103(a) as obvious over Sauerberg et al. (WO 01/79150) in view of Pershadsingh et al. (US 6,028,088) and De la Brouse-Elwood et al. (US 6,200,995).

## CONCLUSION

Applicants submit that the claims are now in condition for allowance. Early notice to that end is earnestly solicited.

In the event the examiner wishes to discuss any aspect of this response, please contact the attorney at the telephone number identified below.

The Commissioner is hereby authorized to charge payment of any fees due with this communication or credit any overpayment to Deposit Account No. 50-4674.

Respectfully submitted,

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